

PATENT
Serial No.: 09/690,677
Docket No. 28150.10
Customer No. 000027683

REMARKS

Applicant respectfully requests reconsideration of this application in view of the following remarks. Claims 13-18, 20 and 21 have been amended. Claims 1-21 are pending. Antecedent basis for the amendments is located throughout Applicant's specification and the original claims. Accordingly, no new matter has been entered.

Oath/Declaration

Under 37 CFR 1.33(a), the Office Action requested a complete post office address. Accordingly, with this paper, Applicant encloses a signed Letter Confirming Inventor's Post Office Address.

Objections

Claims 13-18, 20 and 21 have been amended to overcome the Office Action's objections thereto.

Rejection of the claims

The Office Action rejected claims 1, 7 and 13 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,970,231 ("Crandall") in view of PCT Patent Publication WO 00/30002 ("Sun").

Claim 1 recites:

1. A method performed by a computer system, comprising:
storing a first version of a mass-produced printed paper, the first version including first displayable content at a particular location within the paper; and
translating the first version into a second version of the paper in a manner that replaces the first displayable content with second displayable content at the particular location within the paper, the second version including the second displayable content instead of the first displayable content at the particular location within the paper, and the second version being displayable on a display device as a likeness of the paper with the second displayable content instead of the first displayable content at the particular location within the paper.

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Claim 7 recites:

7. A system, comprising:
a computing device for:
storing a first version of a mass-produced printed paper, the first
version including first displayable content at a particular
location within the paper; and
translating the first version into a second version of the paper in a
manner that replaces the first displayable content with second
displayable content at the particular location within the paper,
the second version including the second displayable content
instead of the first displayable content at the particular location
within the paper, and the second version being displayable on a
display device as a likeness of the paper with the second
displayable content instead of the first displayable content at
the particular location within the paper.

As amended, Claim 13 recites:

13. A computer-readable medium, comprising:
a computer program processable by a computer system for causing the
computer system to:
store a first version of a mass-produced printed paper, the first version
including first displayable content at a particular location
within the paper; and
translate the first version into a second version of the paper in a
manner that replaces the first displayable content with second
displayable content at the particular location within the paper,
the second version including the second displayable content
instead of the first displayable content at the particular location
within the paper, and the second version being displayable on a
display device as a likeness of the paper with the second
displayable content instead of the first displayable content at
the particular location within the paper.

The Office Action acknowledged that Crandall fails to teach "translating the first version into a second version of the paper in a manner that replaces the first displayable content with second displayable content at the particular location within the paper, the second version including the second displayable content instead of the first displayable content at the particular location within the paper."

Nevertheless, the Office Action asserted that, "it would have been obvious to one of

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ordinary skill in the art to modify Crandell, in view of Sun Microsystems, by translating the first version into a second version of the paper in a manner that replaces the first displayable content with second displayable content at the particular location within the paper, the second version including the second displayable content instead of the first displayable content at the particular location within the paper."

However, the Office Action failed to cite any evidence to suggest or teach such a modification of Crandall. Instead, the Office Action merely pointed to Sun at Fig. 5-6, page 14 lines 7-9, page 26 lines 4-16, and page 37 lines 13-24.

MPEP § 2143.01 states: "The mere fact that references can be combined or modified does *not* render the resultant combination obvious unless the prior art also suggests the desirability of the combination." As stated in MPEP § 2142, "...The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness..."

In fact, Crandall actually teaches away from its combination with Sun. For example, at col. 1, lines 15-28, Crandall states, "The current thinking of major publishing companies is to focus on creating an on-line edition for the world wide web. While the world wide web has been certainly gaining in popularity, the internet as it stands is too intricate for the average user to negotiate easily. The internet is especially frustrating to novist [sic] users trying to find articles or other information. It is estimated that there will be approximately ten million home pages by the end of 1996, thus increasing the difficulty of finding anything on the world wide web. It is evident by the fact that very few, if any, newspapers have been able to get sufficient loyal readers of electronic editions to charge access for them, i.e., the electronic editions are generally non-revenue generating items. ***The World Wide Web is a dangerous place for the newspaper to be***" (emphasis added). Accordingly, the remainder of Crandall proceeds to teach a contrary technique.

In contradiction to Crandall, Sun's specification revolves around web site advertisements that are transmitted from a web host to internet users or clients (*see*, e.g., Sun's Abstract and Summary). Moreover, the above-cited portions of Sun fail to even mention the words "translate" or "translation." Accordingly, in this case, the cited aspects of

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Crandall and Sun fail to teach, or even suggest, the desirability of the claimed combinations.

MPEP § 2142 states: "...the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made...The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole.'" Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated.

In this case, the incentive or motivation (supporting the desirability of the claimed combinations) would arise solely from hindsight based on Applicant's teachings.

Consequently, Crandall and Sun fail to provide any basis for combining in a 35 U.S.C. § 103 rejection.

Thus, in view of the reasons stated herein, and for other reasons clearly apparent, the PTO has not met its burden of factually supporting a *prima facie* conclusion of obviousness in this case, and Applicant has no obligation to submit evidence of nonobviousness.

Conclusion

For these reasons, and for other reasons clearly apparent, Applicant respectfully requests allowance of claims 1, 7 and 13.

Dependent claims 2-6 and 19 depend from and further limit claim 1 and therefore are allowable.

Dependent claims 8-12 and 20 depend from and further limit claim 7 and therefore are allowable.

Dependent claims 14-18 and 21 depend from and further limit claim 13 and therefore are allowable.

An early formal notice of allowance of claims 1-21 is requested.

No additional fee is believed due. Nevertheless, to the extent that this Response to Office Action results in additional fees, the Commissioner is authorized to charge deposit account no. 08-1394.

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Applicant has made an earnest attempt to place this case in condition for allowance.
If any unresolved aspect remains, the Examiner is invited to call Applicant's attorney at the telephone number listed below.

Respectfully submitted,


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